



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/219,747      | 12/23/1998  | AKANE YOKOTA         |                     | 4406             |

5514 7590 09/29/2005

FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

TRAN, KHANH C

ART UNIT PAPER NUMBER

2631

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/219,747

Applicant(s)

YOKOTA ET AL.

Examiner

Khanh Tran

Art Unit

2631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-17,19-27,40 and 53-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,7-10,14-16,20-23,27,40 and 53-55 is/are rejected.
- 7) ☒ Claim(s) 4,6,11-13,17,19 and 24-26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 December 1998 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The Continued Prosecution Application (CPA) filed on 11/23/2002 has been entered. Claims 1-4, 6-17, 19-27, 40, 53-55 are pending in this Office action.

### ***Response to Arguments***

2. The allowance of claims 1-4, 6-17, 19-27, 40, 53-55 from the Office action mailed on 08/23/2002 have been withdrawn in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Art Unit: 2631

3. Claims 1-3, 7, 14-16, 20, 27, 40 and 54-55 are rejected under 35

U.S.C. 102(e) as being anticipated by Diachina U.S. Patent 5,835,860.

Regarding to claim 1, in column 7, lines 45-68, Diachina teaches a method for completing a call in a communications system to a mobile station which is participating in a user group, wherein a number of mobile stations participating in the user group is less than a total number of mobile stations in the system, comprising the steps of:

establishing a user group identification code which is distinguishable from mobile station identification numbers assigned to mobile stations in the system, wherein the user group identification code defines ***a user group in which designated mobile stations in the system can selectively request participation***; in column 4, lines 1-15, Diachina further teaches that ***a user group identification code is assigned to the user group by mobile switching center MSC***, which corresponds to the assigning means;

***transmitting a page message from the system to mobile stations participating in the user group using the user group identification code*** when a call to the user group has been requested.

Regarding claim 2, as recited in claim 1, transmit a page message from the system to mobile stations participating in the user group *using the user group identification code* when a call to the user group has been requested. In view of that, the user group identification code corresponds to the claimed multi-address calling in the group.

Art Unit: 2631

Regarding to claim 3, Diachina further discloses in figure 3 (column 5, lines 10-46, column 7, claim 1) a mobile switching center 140 transmitting from the communications system the request of the group identification information to mobile stations participating in the user groups.

Regarding to claims 7 and 20, Diachina's wireless communications system performs radio communication.

Regarding claim 14, claim 14 is rejected on the same ground as for claim 1 because of similar scope.

Regarding claim 15, claim 15 is rejected on the same ground as for claim 2 because of similar scope.

Regarding claim 16, claim 16 is rejected on the same ground as for claim 3 because of similar scope.

Regarding claim 27, claim 27 is rejected on the same ground as for claim 1 because of similar scope.

Regarding claim 40, claim 40 is rejected on the same ground as for claim 1 because of similar scope.

Art Unit: 2631

Regarding claim 54, claim 54 is rejected on the same ground as for claim 1 because of similar scope.

Regarding claim 55, Diachina discloses (column 5, lines 20-46) that a wireless communications system comprising a plurality of mobile stations performs communications on the basis of group ID information assigned to a plurality of mobile stations. A mobile subscriber sends a request for participating in a user group while roaming. The Mobile Switch Center, responsible for the area in which the mobile station is located, assigns the mobile subscriber a user group an identification code. The mobile subscriber stores the user group identification and performing the group communication in the group using the user group identification.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2631

4. Claims 8-10 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Diachina U.S. Patent 5,835,860 in view of Smith U.S. Patent 4,850,036.

Regarding to claims 8, and 21, Diachina does not teach a specific method of communications being used for communicating between stations.

Smith discloses a radio communication system using synchronous frequency hopping transmissions. As taught by Smith in column 1, lines 35-68, in a frequency-hopping radio communication system, interference from a plurality of communication stations can be avoided by uniquely assigning each communication station a set of hopping frequencies, therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention that Smith's frequency hopping method for transmissions in Diachina's wireless communications system can be modified to use frequency-hopping communication as taught in Smith invention.

Regarding to claims 9 and 22, Smith discloses a control unit transmitting to each of plurality of stations a first control message assigning frequency-hopping sequence and identifying to each slave station a frequency-hopping sequence to be used for transmission and reception from the control unit.

Regarding to claims 10 and 23, Smith discloses all slave station transmissions are synchronized to the control unit transmissions.

Art Unit: 2631

5. Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Diachina U.S. Patent 5,835,860.

Regarding claim 53, claim 53 is rejected on the same ground as for claim 1 because of similar scope. Furthermore, Diachina does not teach a computer program product as set forth in the claimed application. Nevertheless, with the advance of computer technology and computer programming, a person of an average skill in the art would have been motivated to implement a computer program product as set forth in the application claim.

#### ***Allowable Subject Matter***

6. Claims 4, 6, 11-13, 17, 19 and 24-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



Art Unit: 2631

Vilmur U.S. Patent 6,373,829 B1 discloses "Method And Apparatus For Group Calls In A Wireless CDMA Communication System Using Outbound Traffic Channels For Individual Group Members".

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh Tran whose telephone number is 571-272-3007. The examiner can normally be reached on Monday - Friday from 08:00 AM - 05:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mohammad Ghayour can be reached on 571-272-3021. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KCT

*Khanh Cong Tran*

*09/28/2005*

Examiner KHANH TRAN